REMARKS

The Office Action of November 28, 2008 has been carefully considered. Claims 1-2 were pending in the application and were rejected. Claim 1 has been amended and claim 2 is cancelled. Claim 3 is new and is based on claim 1. The amended and new claims do not introduce new subject matter. They are supported throughout the specification, for example by Example 1 at pages 6-8 and original claim 2.

In the Office Action, the Examiner indicated that Applicant's IDS would be attached. However, it was not included. Applicant requests that the form PTO/SB/08b be returned with Examiner signature to indicate it has been considered.

The amendment to page 4 of the specification is not new matter. It is supported by original claim 2.

35 USC 102

Claim 1 was rejected under 35 USC 102(b) as being anticipated by US 5,834,049. Applicant traverses the rejection.

Claim 1 presently recites a process that requires steps not disclosed in US 5,834,049. For this reason the claim is novel over the art.

Claim 3 recites that the rice is cooked to form a gruel and requires other steps not disclosed in US 5,834,049. As such it is novel over US 5,834,049.

35 USC 103

Claim 2 was rejected under 35 USC 103(a) as being unpatentable over US 5,834,049, as applied to claim 1 in view of the abstract of Ishida (JP403198756A) or in view of the recipe for "Chinese Chicken and Rice Porridge" (Gourmet 2000). Limitations of claim 2 have been incorporated into claim 1. The rejection is treated as though it applies to the present claims. Applicant traverses the rejection.

The Examiner conceded that Kageyama, US '049 does not disclose adding 30-70% of the cooking water prior to the cooking process and the residual amount of the cooking water prior to sealing. The Examiner attributed this missing component of the process to Ishida or Gourmet

(2000). However, the Examiner conceded that neither of these references disclose the relative quantities of cooking water added before and after the cooking process (Off. Act. at para. 11 and 17).

In order to overcome the defect in this ground for the rejection, the Examiner relied on case law of *In re Boesch and Staney* 617 F.2d 272, 205 USPQ 215 (CCPA 1980) for the premise that discovering the optimum value of a result effective variable involves only routine skill in the art. The Examiner's reliance on the holding of *In re Boesch* is misplaced because the facts of the instant application do not match the facts that the court considered in the1980's case. In the case, the court was presented with the situation where the claimed composition recited several metals present in a particular range of percentage by weight. The court noted that "each of the ranges of constituents in [the] claimed alloys overlaps ranges disclosed by [the two prior art references]" *Boesch* at 205 USPQ 218, and also noted that all the limitations of the claim were disclosed in the prior art, *Boesch* at 219. Given that all limitations were disclosed and that the ranges overlapped, the court held that "this accords with the rule that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." *Boesch* at 205 USPQ 219 (emphasis added). However, in the present situation, the prior art does not disclose all the limitations of the claim. The prior art references either fail to disclose any two-step cooking process of adding cooking water before cooking and then adding residual cooking water after the first cooking, or, alternatively, the reference fails to disclose any range percentage of water added. This situation lacks any overlap of values between the prior art and the present claims, as there was in the case of *Boesch*. Thus it cannot be said that this was a known process, and *In re Boesch* cannot be applied to account for the defect in the grounds for the rejection. Since the Examiner has not shown that it was within the skill of the art to attain the present inventive process, there has been no prima facie showing of unapatentability.

In further elucidation of the defects of the grounds of the rejection, the Examiner stated that Ishida discloses that rice is *cooked by adding hot water* (constitution, line 3) and then hydrating the mixture to add the residual amount of the cooking water (constitution line 7). Applicant disagrees. In fact, at line 3, Ishida does not disclose cooking the rice, but merely discloses a step using water at about 60°C or greater for getting the rice to absorb water (which

does not require cooking). Ishida then discloses at line 7 et seq, taking the rice which has absorbed water and treating the rice with water at about 80°C or greater in a pressure cooker to accomplish the cooking step. Ishida does not disclose the two-part cooking process, as in the present claimed process.

In the present claims, there is a step of rinsing raw rice and a step of immersing the raw rice in water prior to sterilization and then a step of adding cooking water and a step of cooking the rice in two substeps, (substep 1 is with the first addition of cooking water, substep two is with a second addition of cooking water and leaving the rice bowl to stand after being sealed), followed by a step of cooling the rice in a water bath. Neither Ishida nor Kageyama disclose this step of cooling the rice in a water bath. To the contrary, the Kageyama process is quite different and even if modified by using the Ishida cooking process, the combination would not be the same as the claimed invention. This is additionally because the present claimed process discloses that after sealing and wrapping the bowl, the rice is then cooked by leaving the bowl aside for several minutes and then the bowl is cooled in a water bath. In contrast, Kageyama does not leave the bowl aside, but teaches that following the sealing step, the cooked rice is further steamed and then cooled and dried (col. 5, lines 36-40).

The reliance on Gourmet (2000) is similarly incorrect. The Examiner stated that the Gourmet recipe discloses a method for cooking the rice product wherein "following the cooking process a second addition of water is made (paragraph 3)". Applicant disagrees. That disclosure does not provide the missing process steps. The missing cooking step requires that the cooking water is first added into the plastic bowl prior to cooking, the residual amount of cooking water is added before the sealing step and the bowl is left aside for further cooking and then cooled in a water bath.

Gourmet (2000) describes a first cooking step of cooking chicken without rice (paragraph 1). Then the recipe calls for adding rice to the stock and cooking (paragraph 3). The recipe then states that congee, if left standing, will thicken and can be thinned if necessary by adding water. There is no instruction, as in the claim, of a two part cooking process wherein 30-70 wt % of cooking water is first added and then the residual amount is added, the bowl is wrapped and allowed to cook by standing, and then cooled in a water bath. To the contrary, in the Gourmet

(2000) recipe, the instruction is to cool the congee uncovered. Thus Gourmet (2000) teaches away from the claimed method. "[P]roceeding contrary to the accepted wisdom . . . is 'strong evidence of unobviousness.'" In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986) (citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1552, 220 USPQ 303, 312 (Fed. Cir. 1983)). For all the above reasons, Applicant respectfully asserts that the prior art combinations suggested by the Examiner do not render the claims unpatentable.

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance and request that all claims be allowed. The Examiner is invited to contact the undersigned should he believe that this would expedite prosecution of this application. It is believed that no fee is required. The Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 13-2165.

Respectfully submitted,

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